

BS01378

U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629
Response to March 20, 2006 Office Action

REMARKS

In response to the office Action dated March 20, 2006, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents.

Claims 21-53 are pending in this application. Claims 1-20 were previously canceled.

The United States Patent and Trademark Office (the "Office") rejected claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* Claims 26, 31, 37, 45-47, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks* in view of U.S. Patent 6,202,210 to Ludtke *et al.*

Claims 21-53, however, are not anticipated nor obviated. Because neither *Hendricks* nor *Ludtke* teach or suggest all the features of the pending claims, the pending claims must distinguish over the cited documents.

Rejection of Claims Under 35 U.S.C. § 102 (e)

Claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* As the Assignee has previously argued, the patent to Hendricks *et al.* fails to teach every feature recited in the claims. *Hendricks*, then, cannot anticipate these claims. The 35 U.S.C. § 102 (e) rejection must, therefore, be removed.

Hendricks does not anticipate the independent claims. All the independent claims recite features that are not disclosed or contemplated by *Hendricks*. Independent claim 21, for example, recites "*predicting future buttons pushed by the subscriber.*" Support for such features may be found at least at paragraph [0019] of U.S. Application 10/017,742, filed December 14,

BS01378

U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629
Response to March 20, 2006 Office Action

2001 and entitled "System and Method For Utilizing Television Viewing Patterns," which was incorporated by reference into this application. A "clean" version of independent claim 21 is reproduced below, and independent claims 27, 32, and 53 recite similar features.

21. A processor-implemented method for predicting content, comprising:

- receiving content from a content database;
- receiving subscriber actions from a subscriber-action database, the subscriber-action database storing information related to buttons pushed by a subscriber at a remote control while viewing content;
- processing the content received from the content database and the subscriber actions; and
- predicting future buttons pushed by the subscriber.

No where does *Hendricks* teach or suggest all these features. *Hendricks* completely fails to teach or suggest at least "*predicting future buttons pushed by the subscriber.*" Examiner Ouellette is correct — *Hendricks* receives "programs watched information" to "develop a program line-up." U.S. Patent 6,463,585 to Hendricks *et al.* (Oct. 8, 2002) at column 11, lines 42-44 and 51-54. *Hendricks* also mentions a remote control and "clickstream data." *Id.* at column 10, lines 38-60 and at column 20, lines 26-27. Yet no where does *Hendricks* teach, suggest, or contemplate "*predicting future buttons pushed by the subscriber.*" As Examiner Ouellette must realize, the claimed feature "*predicting future buttons pushed by the subscriber*" cannot be reasonably interpreted from the teachings of *Hendricks*. Because *Hendricks* is completely silent to at least this feature, the patent to Hendricks *et al.* cannot anticipate claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53. Examiner Ouellette is thus respectfully requested to remove the § 102 (e) rejection of claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53.

Rejection of Claims Under 35 U.S.C. § 103 (a)

Claims 26, 31, 37, 45-47, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks* in view of U.S. Patent 6,202,210 to Ludtke *et al.* If the Office wishes to

BS01378

U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629
Response to March 20, 2006 Office Action

establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

1. The Proposed Combination of *Hendricks* and *Ludtke* Does Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejection is Improper

Claims 26, 31, 37, 45-47, and 49 are not obvious in view of *Hendricks* and *Ludtke*. These claims are all dependent upon their respective base claim and, thus, incorporate the same distinguishing features. No where, for example, do *Hendricks* and *Ludtke* teach or suggest "predicting future buttons pushed by the subscriber." One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Hendricks* and *Ludtke* to obviate claims 26, 31, 37, 45-47, and 49. Because the proposed combination of *Hendricks* and *Ludtke* does not teach or suggest all the claimed features, the § 103 rejection of these claims must be removed.

2. Because No "Teaching, Suggestion, or Motivation" was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include "some teaching, suggestion, or motivation" to combine prior art that is found "either in the references themselves or in the knowledge generally available to one of ordinary skill." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Here, however, the Examiner's *prima facie* case fails to include any teaching, suggestion, or motivation. The § 103 (a) rejection makes no attempt to satisfy the Examiner's burden.

BS01378

U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629
Response to March 20, 2006 Office Action

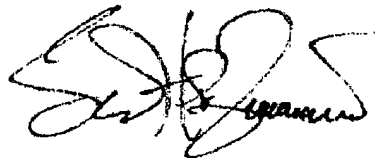
Examiner Ouellette cites no passage from *Hendricks* or *Ludtke* to support his *prima facie* burden. Examiner Ouellette also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* case for obviousness, then, is at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Assignee thus respectfully asserts that the § 103 (a) rejection of claims 26, 31, 37, 45-47, and 49 should be removed.

3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective for another reason. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of claims 26, 31, 37, 45-47, and 49 should be removed.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390

page 12

BS01378

U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629
Response to March 20, 2006 Office Action